

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 1-17 remain in the application. Claims 4 and 7 have been withdrawn from consideration.

In item 3 on page 2 of the Office action, claims 1, 2, 5, 6, 16, and 17 have been rejected as being fully anticipated by Agradi et al. (DE 36 27 732 A1) (hereinafter "Agradi") under 35 U.S.C. § 102.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and the claims have, therefore, not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 1, 16, and 17 call for, *inter alia*:

a heating device disposed on the pump housing in heat-conducting contact with the interior of the pump housing.

The Agradi reference discloses a heating zone (17) and a pump section (38) (column 5, lines 56-62). The heating zone (17) has a heating element (23) that is spirally disposed around an outer perimeter (28) of a pipe section (22) (column 6, lines 7-30). The Agradi reference discloses that the pipe section (22) has an end (35), which is connected to a flange (26) that is provided on the pump housing of the pump (40) (column 6, line 63 to column 7, line 2).

The reference does not show a heating device disposed on the pump housing in heat-conducting contact with the interior of the pump housing, as recited in claims 1, 16, and 17 of the instant application. The Agradi reference discloses that the heating element (23) is disposed on the pipe section (22). The pipe section (22) is in turn connected to the flange provided on the pump housing of the pump (40). The pipe section is attached to the pump housing and is not part of the pump housing. Accordingly, Agradi does not disclose that the heating element is disposed on the housing. This is contrary to the invention of the instant application as claimed, in which a heating device is disposed on the pump housing in heat-conducting contact with the interior of the pump housing.

Since claim 1 is believed to be allowable, dependent claims 2, 5, and 6 are believed to be allowable as well.

Even though claims 5 and 6 are believed to be allowable, the following remarks pertain to claims 5 and 6. The heating device in the instant application corresponds to the heating element (23) in Agradi. For example, in claims 5 and 6 of the instant application, an electrical resistance heater and a tubular heater are respectively disclosed. Agradi does not show or suggest disposing either an electrical resistance heater or a tubular heater on the pump housing as claimed in the instant application.

In item 5 on page 2 of the Office action, claim 3 has been rejected as being obvious over Agradi (DE 36 27 732 A1) in view of Langer (U.S. Patent No. 5,692,885) under 35 U.S.C. § 103.

Applicants respectfully disagree with the Examiner's comments in item 5 of the Office action, that "It therefore would have been obvious to one having ordinary skill in the art to modify the device of Germany '732, to have the heating device on the pump housing facing the motor for the purpose of providing a more compact arrangement." The Agradi reference explicitly teaches away from such a modification, furthermore, such a modification would destroy the function of Agradi. The Agradi reference discloses using stirring rotors (46, 46a, 46b, and

46c) in the pipe section (22) (Figs. 2, 4, 5, and 6) to generate a strong swirling of the liquid. As a result, deposits of cleaning agent residues and the like are prevented, and because the heating element (23) is spirally wound about the pipe section (22), there is a substantial improvement in the heat transfer from the electric heating element (23) to the liquid. Accordingly, the construction of the invention disclosed by Agradi is imperative (i.e. the heating element (23) being disposed on the pipe section (22)) because the interaction of the swirling liquid in the pipe section is the very core of Agradi's invention. Based on the above-provided comments, the modification suggested by the Examiner is explicitly taught away from and would destroy the core of Agradi's invention. Therefore, a person of ordinary skill in the art would not modify Agradi with the teaching of Langer to have the heating device on the pump housing facing the motor, as suggested by the Examiner.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in

cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the

problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

In item 6 on page 3 of the Office action, claims 8 and 9 have been rejected as being obvious over Agradi (DE 36 27 732 A1) under 35 U.S.C. § 103. Since claim 1 is believed to be allowable, dependent claims 8 and 9 are believed to be allowable as well.

In item 7 on page 3 of the Office action, claims 10-13 have been rejected as being obvious over Agradi (DE 36 27 732 A1) in view of Wright (U.S. Patent No. 4,594,500) under 35 U.S.C. § 103. Wright does not make up for the deficiencies of Agradi. Since claim 1 is believed to be allowable, dependent claims 10-13 are believed to be allowable as well.

In item 8 on page 3 of the Office action, claims 14 and 15 have been rejected as being obvious over Agradi (DE 36 27 732 A1) in view of either Stover et al. (U.S. Patent No. 4,429,845), Slayter (U.S. Patent No. 2,066,127) or Bennett (GB 2 212 901 A) under 35 U.S.C. § 103. Neither Stover et al., Slayter, nor Bennett make up for the deficiencies of Agradi. Since claim 1 is believed to be allowable, dependent claims 14 and 15 are believed to be allowable as well.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either

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show or suggest the features of claims 1, 16, or 17. Claims 1, 16, and 17 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 1, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 1-17 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.

Petition for extension is herewith made. The extension fee for response within a period of two months pursuant to Section 1.136(a) in the amount of \$420 in accordance with Section 1.17 is enclosed herewith.

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Please charge any other fees which might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner & Greenberg P.A., No. 12-1099.

Respectfully submitted,

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